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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,586	03/07/2002	Hiroshi Koyama	108421-00036	7690

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EXAMINER

MCNEIL, JENNIFER C

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 07/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/091,586	Applicant(s) KOYAMA ET AL.	
	Examiner Jennifer C McNeil	Art Unit 1775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 1 and 2 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claim 5 is objected to because of the following informalities: Claim 5 states “fatigue failure is exist in”. This phrase is confusing and the limitation of the claim is not clearly understood. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 states “fatigue failure is exist in”. This phrase is confusing and the limitation of the claim is not clearly understood. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 3, 6, 7, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Brown et al (US 4,854,150). Brown teaches tubular workpiece with a thickness ratio of approximately 24% (col. 8, lines 33-38). Brown also teaches peening the workpiece to withstand stress corrosion cracking (col. 14, lines

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46-55). The process limitations of electroseaming, hot state or warm state are not considered to give structural definition over the article of the prior art.

Regarding claim 6, Brown teaches a thickness ratio of 24%.

Regarding claim 7, Inoue does not specifically discuss a bead. However, the claim is to the removal of a bead. The article of Brown does not teach a bead and is considered to not have a bead. Therefore, the final product of Brown is considered to meet the limitation by having no bead present.

Regarding claim 8, as the article of Brown is considered to meet the structural limitations of the instant claims, it is fully expected to also possess similar properties.

Claims 3, 6, 7, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Inoue (JP 2000-233625). Inoue teaches a hollow stabilizer with a thickness ratio of 20-27 % and further teaches shot peening and rust preventive painting. The process limitations are not considered to give structural definition over the article of the prior art. The process limitations of electroseaming, hot state or warm state are not considered to give structural definition over the article of the prior art.

Regarding claim 6, Inoue teaches a thickness ratio of 20-27%.

Regarding claim 7, Inoue does not specifically discuss a bead. However, the claim is to the removal of a bead. The article of Inoue does not teach a bead and is considered to not have a bead. Therefore, the final product of Inoue is considered to meet the limitation by having no bead present.

Regarding claim 8, as the article of Inoue is considered to meet the structural limitations of the instant claims, it is fully expected to also possess similar properties.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Siecinski et al (US 6,206,392) in view of Brown et al (US 4,854,150). Siecinski teaches a stabilizer bar having a diameter of 18-50 mm and a thickness in the range of 10-25% of the diameter. These ranges include a thickness ratio of 25% (4.5 thickness/18 diameter). Siecinski does not teach shot peening of the bar. Brown a hollow stabilizer bar having a similar thickness ratio to that of Siecinski and further teaches peening the workpiece to withstand stress corrosion cracking (col. 14, lines 46-55). It would have been obvious to one of ordinary skill in the art at the time of the invention to peen the stabilizer of Siecinski in the manner taught by Brown to provide a bar with the ability to withstand stress corrosion cracking.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue (JP 2000-233625). Inoue teaches a hollow stabilizer having a thickness ratio of 20-27%. The stabilizer is shot peened after a bending process. Inoue does not teach a thickness ratio of greater than 27%. Inoue teaches that it is difficult, but not impossible to form a pipe with a thickness ratio above 27%. This clearly shows that one of ordinary skill in the art would be capable of forming a pipe having a thickness ratio greater than 27%, therefore, absent a showing of unexpected results, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a stabilizer having a thickness ratio of greater than 27%.

Response to Arguments

Applicant's arguments filed April 23, 2004 have been fully considered but they are not persuasive.

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Applicant argues that Brown fails to teach that the pipe-shaped product is electroseamed and that it is compressed to reduce the diameter thereof. The final product of Brown is considered to meet the structural limitations of the claims. As stated above, the process limitations of electroseaming, hot state or warm state are not considered to give structural definition over the article of the prior art. Applicant has not provided any evidence or substantive argument that these method limitations provide structural distinction over the prior art. Applicant has added the limitations of hardening and tempering. Brown includes tempering and hardening steps.

Regarding Inoue, applicant argues that Inoue applies a cold drawing process, and that the instant article is formed by heat treatment. As stated above, the process limitations of electroseaming, hot state or warm state are not considered to give structural definition over the article of the prior art. Applicant has not provided any evidence or substantive argument that these method limitations provide structural distinction over the prior art. Applicant has added the limitations of hardening and tempering. Inoue includes hardening and strain aging and annealing. This is considered to meet the limitation.

Regarding Siecinski, applicant argues that the reference fails to teach compression in a temperature range of a hot state or a warm state. . As stated above, the process limitations of electroseaming, hot state or warm state are not considered to give structural definition over the article of the prior art. Applicant has not provided any evidence or substantive argument that these method limitations provide structural distinction over the prior art.

New claims 4-8 have necessitated new ground of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer C McNeil whose telephone number is 571-272-1540. The examiner can normally be reached on 9AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on 571-272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jennifer McNeil
Primary Examiner